

ATTACHMENT B

46 USPQ2d Ex parte Lemoine 1421

to the board's Standard Operating Procedure No. 94-02, "the opinion below has been designated as precedent on the sole issue of the construction of 35 U.S.C. § 134."]

James L. Rowland, of Greenblum & Bernstein, Reston, Va., for applicant.

Before McKelvey, chief administrative patent judge, and Stoner, Meister, McQuade, and Schafer, administrative patent judges.

Per curiam.

This appeal was initially argued on March 13, 1994, before a merits panel consisting of Judges Stoner, Meister, and McQuade. The panel was unable to reach a decision. Judge Stoner would have reversed, Judge Meister would have affirmed, and Judge McQuade would have dismissed for lack of jurisdiction. Thereafter, an expanded five-member panel consisting of Chief Judge McKelvey and Judges Stoner, Meister, McQuade, and Schafer voted to rehear the appeal. The appeal was reheard on June 20, 1994.

The expanded panel has reached a split decision.

By a vote of 4-1, the expanded panel determines that the Board has jurisdiction. Judge McQuade dissents.

By a 3-1 vote, the expanded panel affirms on the merits. Judge Stoner dissents. Judge McQuade declines to participate on the merits.

Judge Schafer's majority opinion, Judge Stoner's dissent on the merits, and Judge McQuade's dissent on jurisdiction follow.

Schafer, administrative patent judge.

Applicant appeals the final rejection of claims 24 to 52 and 54 to 58, all the claims in the application. Claims 54 and 36 are representative. Claims 54 and 36 are set forth below:

54. An apparatus for mounting a boot upon a ski, the boot adapted to be maintained between a front safety binding and a rear safety binding, said apparatus comprising:

(a) an intermediate support plate for affixation to the ski for vertically supporting the boot and for having secured thereon at least one of said front safety binding and said rear safety binding;

(b) at least one support element having a predetermined size and shape to enable said at least one support element to be positioned between said intermediate support plate and an upper surface of the ski, to enable at least vertical forces to be

transmitted between said intermediate support plate and the ski;

(c) means for longitudinally displacing said at least one support element beneath said intermediate support plate and between said intermediate support plate and the ski for selectively adjusting longitudinal positions of said at least one support element; and

(d) means for immobilizing said at least one support element in predetermined longitudinal positions between said intermediate support plate and the ski.

36. The apparatus of claim 54, further comprising means for vertically retaining said intermediate support plate relative to said ski.

The examiner made three rejections:

1. The rejection of claims 24, 25, 31-52, and 54-55 under 35 U.S.C. § 112, second paragraph as indefinite.

2. The rejection of claims 24-27, 31-33, 43-45 and 54-58 under 35 U.S.C. § 103 as unpatentable over the combination of the teachings of the Kuchler¹ and Smolka² patents; and

3. The rejection of claims 28-30, 36 and 42 under 35 U.S.C. § 103 as unpatentable over the combined teachings of the Kuchler, Smolka and Weigl³ patents.

The board also *sua sponte* raised the question of whether "any of applicant's" claims had been twice rejected⁴ as required by 35 U.S.C. § 134 and thus whether the jurisdiction of this board was properly invoked.

Procedural History

Because of the jurisdictional issue, we review the relevant procedural history of this application and its parent application. 07/639,095.

The parent application was originally filed with claims 1-22. In the first Office action the examiner made a variety of formal objections, rejected all the claims for indefiniteness under 35 U.S.C. § 112, ¶ 2, and rejected claims 1-8, 16 and 17 under 35 U.S.C. § 103. In the latter rejection the examiner relied upon a combination of the teachings of Kuchler and Smolka, as evidence that the claimed subject matter would have been obvious.

In response to the rejection, applicant, *inter alia*, canceled all the claims (claims

¹ Kuchler 4,804,200 February 14, 1989
² Smolka et al. 3,797,844 March 19, 1974
³ Weigl 4,251,090 February 17, 1981

46 USPQ2d Ex parte Lemoine

U.S. Patent and Trademark Office
Board of Patent Appeals and Interferences.

Ex parte Lemoine

No. 94-0216

Decided December 27, 1994

Released March 12, 1998

PATENTS

1. Practice and procedure in Patent and Trademark Office — Board of Patent Appeals and Interferences — Jurisdiction (§110.1103)

Word "claims". In 35 USC 134, which provides that patent applicant, "any of whose claims have been twice rejected," may appeal from decision of primary examiner to Board of Patent Appeals and Interferences, should be construed consistently with its use in 35 USC 132 to mean "claims for a patent," rather than particular "claims of an application."

2. Practice and procedure in Patent and Trademark Office — Board of Patent Appeals and Interferences — Jurisdiction (§110.1103)

Board of Patent Appeals and Interferences has jurisdiction over appeal filed by applicant who was denied patent three times, since 35 USC 134 provides that applicant may appeal if applicant's "claims" have been twice rejected, since term "claims" in this context is properly construed to mean "claim for a patent" as used in 35 USC 132 rather than particular "claim of an application," and since applicant therefore may file appeal provided applicant has twice been denied patent.

Appeal from rejection of all claims in patent application.

Patent application of Philippe Lemoine, serial no. 07/884,875, filed May 18, 1992. From examiner's rejection of all claims in application, in office action that was not made final, applicant appeals. Affirmed in part; Stoner, administrative patent judge, concurring in part and dissenting in part in separate opinion; McQuade, administrative patent judge, dissenting in separate opinion. [Editor's Note: The Board of Patent Appeals and Interferences states that, pursuant

¹ Application for patent filed May 18, 1992. According to applicant, the application is a continuation of Serial No. 07/639,095, filed January 9, 1991, abandoned.

es of trademark dilution, the L.L. Bean est warned that courts should still take account First Amendment principles on evaluating such claims. Cases of unauthorized uses of trademarks on products whose principal purpose is to convey a message require a balancing of the harm feared by the trademark owner against the benefit derived by the parodist and the public from the unauthorized use of a trademark, a product designed to convey a message."

at 32 n.4.
In this case, plaintiff's description of Barbie as "lewd and lascivious," arguably echoes those terms. Even if the song were rendered as vulgar as Matel's parodies, it is parody of the "party-girl" image Barbie already have among some members of general public. (See, e.g., Folkes Decl., 22). Absent stronger evidence that the song actually tarnishes Barbie's image, until is unlikely to succeed on its trademark dilution claims."

Irreparable Injury and the Balance of hardships

[6] Plaintiff has failed to show that it is likely to succeed on its trademark infringement and dilution claims. Nor does it appear at the balance of hardships "tips sharply" in favor. *Big Country Foods*, 868 F.2d at 188.

CONCLUSION

For the foregoing reasons, this Court DENIES plaintiff's motion for a preliminary injunction. The Court also DENIES plaintiff's and defendants' motions to strike each her's supporting declarations.
IT IS SO ORDERED.

Plaintiff cites the Ninth Circuit's *Academy Motion Picture* case to support its sole law claim. 944 F.2d 1446 119 USPQ2d 4911. In that case, a company produced a gold-colored award statue almost identical to the famous Oscar awards given each year. *Id.* at 449-50. The "only significant differences between the two [were that] the Star Award is two inches shorter than the Oscar, and holds a star rather than a sword." *Id.* Unlike that case, defendants have not copied Barbie's design as a doll or even any of the music Matel puts out under her name. Defendants are parodying Barbie, not "whittling away" at consumers' ability to distinguish between competing brands.

Ex parte Lemoine

46 USPQ2d

and submitted new claims 23-53. The examiner issued a final Office action, rejecting claims 23-53 as indefinite under 35 U.S.C. § 112, 2nd sentence, and claims 23-27, 36, 43-45 and 53 as being directed to an abstract idea which would have been obvious over the combined teachings of the prior art and Smolka references. Claims 23, 36 and 42 were also rejected under 35 U.S.C. § 103 as unpatentable in view of the prior art. The examiner noted that applicant separately argued the features of the independent claims and that the patentability of dependent claims stood or fell with the independent claims.

Applicant responded to the final rejection with a notice of appeal, and a proposed amendment. The examiner denied entry of amendment on the basis that the amendment raised new issues and did not simplify the number of issues on appeal. Applicant filed another proposed amendment. The examiner again denied entry of amendment on the basis that the amendment was not in compliance with 37 CFR § 1.121(b), raised new issues and did not materially reduce or simplify the issues for appeal.

Applicant then submitted an appeal brief, and chose to refile the application as a "wrapper continuation" (EWC) under 37 CFR § 1.62. By a preliminary amendment, applicant canceled claims 23 and 53, and claims 54-58 and made minor amendments to claims 24-26, 28, 29, 31-33, 36, 37, and 43-46.

The examiner essentially repeated the grounds of rejection. Claims 24, 25, 26, 27, 28, 29, 31, 32, 33, 36, 37, 38, 39, 40, 41, 42, 43, 44, 45, 46, 47, 48, 49, 50, 51, 52, 54 and 55 were rejected as indefinite under 35 U.S.C. § 112, 2nd sentence. Claims 24-27, 33, 43-45, and 54-58, were rejected under 35 U.S.C. § 103 as unpatentable over the combination of the Kuchler and Smolka disclosures. Claims 28-30, 36 and 42 were rejected under 35 U.S.C. § 103 as unpatentable in view of the combined teachings of Kuchler, Smolka and Weigl. The Office action was not made final.

Applicant's response to the Office action was subsequently filed a proposed amendment. The examiner held the application to be abandoned. He felt the notice of appeal was improper at the particular stage of the prosecution, citing 35 U.S.C. § 134 (37 CFR § 1.19). He also felt that the amendment was untimely under 37 CFR §§ 1.133 and 1.136.

Applicant filed a paper captioned "Request to Withdraw Holding of Abandonment and Provisional Petition to Revive." With

Ex parte Lemoine

46 USPQ2d

conclude that appellant had the right to appeal the rejections and we have jurisdiction.

To reach a decision requires us to construe the word "claims" as used in § 134. The word is susceptible to at least two interpretations. It can refer to the claims of an application, i.e., the "one or more claims particularly pointing out and distinctly claiming the subject matter" of the invention required by 35 U.S.C. § 112, 2nd sentence. Or the word can be used in a more general sense to refer to claims "for a patent" as it is used in 35 U.S.C. § 132. In this latter sense, the word is synonymous with a request or demand for a patent.

[1] Section 134 merely uses the word "claims." We must, therefore, decide which construction to give to the statute. We conclude that "claims" in § 134 should be construed consistently with its use in § 132 to mean "claims for a patent" rather than particular "claims of an application."

[2] Section 134 is part of Chapter 12 of Title 35. Chapter 12 is titled "Examination of Application" and sets forth the general procedures to be followed in the Office for examination. Sections 131 to 134 provide the general procedures relating to *ex parte* examination. In relevant part, these sections specify that (1) an examination shall be made (§ 131); (2) if "any claim for a patent" is rejected, the applicant shall be informed of the bases of the rejection (§ 132); (3) if the applicant persists in the "claim for a patent" with or without amendment, the application shall be reexamined (§ 132); and (4) if applicant's claims have been twice rejected, the applicant may appeal (§ 134). Considering these sections together, we conclude that the "claims" as used in § 134 is a reference to the repeated "claim for a patent" as used in § 132 rather than a reference to a particular claim "of an application." Under our interpretation, so long as the applicant has twice been denied a patent, an appeal may be filed. So construing the statute, we conclude that applicant's claims for a patent have been twice rejected. Applicant has been denied a patent three times. Applicant, therefore, had the right to appeal and we, accordingly, have jurisdiction.

Judge McQuade's dissent on jurisdiction

Judge McQuade's dissent argues that we have failed to provide authority for our interpretation of § 134. This is incorrect since the authority is Chapter 12 of Title 35. We have construed "claims" in § 134 *in pari materia* with the other sections of that Chapter and the examination scheme of Chapter 12 as a whole. Sections 132 and 134 were promul-

gated at the same time and both are part of the statutory framework setting forth the procedures for the patent examination process. Accordingly, the two sections should be interpreted *in pari materia*. *Erlengauß v. United States*, 409 U.S. 239, 243, 93 S.Ct. 477, 480 (1972). It is appropriate, therefore, to give the word the same meaning in both sections. Our construction is also consistent with the principle that statutes giving the right to appeal are to be liberally construed. *United States v. Mfabiyi Chemical Corp.*, 576 F.2d 368, 374 (CCPA 1978).

The dissent argues that our construction is inconsistent with the "construction which traditionally has been accorded 35 USC § 134." The dissent relies on *In re Szafrin*, 422 F.2d 443, 164 USPQ 632 (CCPA 1970) and *In re Hengst*, 440 F.2d 1395, 169 USPQ 473 (CCPA 1971). In *Szafrin* the court noted:

Those sections [132 and 134] do not require that each and every claim presented during the prosecution of an application must be twice examined and twice rejected on the same ground. Section 134 appears to imply the contrary since it permits an appeal to be taken when *any* claim has been twice rejected. Nevertheless, the claims here in question have been twice rejected, contrary to appellants' allegations, since the examiner rejected them on the grounds of undue multiplicity and as being based on new matter prior to the rejection in his Answer. [Emphasis original.]

422 F.2d at 446, 164 USPQ at 635. In *Hengst*, the court noted that it is clear that, for the board to have some jurisdiction in a case, only one claim need be twice rejected, and that event occurred here. [Emphasis original.]

440 F.2d at 1403, 169 USPQ at 479. We do not view these cases as being inconsistent with our interpretation of the statute. In each case, the applicant's claim for a patent was twice denied. We believe the dissent errs in interpreting the court's rationale as stating necessary rather than sufficient conditions for jurisdiction. The Federal Circuit has cautioned against extending legal principles to cases having different fact situations. *FMG Corp. v. Manitowoc*, 835 F.2d 1411, 1417 n.12, 5 USPQ2d 1112, 117 n.12 (Fed. Cir. 1987).

The dissent also errs in construing "any of whose claims" has been twice rejected" to mean "any of whose claims, which do not differ in substance and scope from previously rejected claims, has been twice rejected." There is simply no support for this limited view in the statute.

1425

Ex parte Lemoine

46 USPQ2d

The § 112 rejection.

The examiner has rejected claims 24-25, 26, 54 and 55 under 35 U.S.C. § 112, second paragraph as indefinite. The examiner indicates that these claims only positively and distinctly claim the interconnection of a binding leaving the positive interconnection of the other safety binding novel.

We reverse this rejection. At the outset we note that the examiner has apparently interpreted the claims as requiring a "binding or binding." However, none of the claims positively require that bindings be attached to an intermediate support plate. For example, in 54 recites that the intermediate support plate is "for" having a binding secured thereon.

In any event, we fail to see how lack of a reference to a second binding makes the claim indefinite. A claim is indefinite if it is not clearly delineate the boundary between the claimed and unclaimed subject matter. See *In re Vogel*, 422 F.2d 438, 442, 1 USPQ 619, 622 (CCPA 1970). ("A claim is a group of words defining only the subject of the patent monopoly.") See *In re Vancro Machine & Tool, Inc.*, 752 F.2d 1564, 1577 n.5, 224 USPQ 617, 625 n.5 (Fed. Cir. 1985). (The claim sets forth the steps and bounds of the rights which the applicants seek to obtain). In determining if a claim is indefinite, claim language is analyzed in light of the teachings of the prior art and in light of the particular application disclosure as it would be interpreted by one of ordinary skill in the art. *In re Moore*, 9 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). The fact that only one binding is recited does not obscure the boundary between the claimed and unclaimed subject matter or otherwise make the claimed subject matter unclear. The ordinary person working in this art would not, in our view, have any problem ascertaining the scope of a claimed subject matter. In order to fail within the literal scope of the claim, the intermediate support plate need only be "or" securing a single binding.

The 35 U.S.C. § 103 rejections

We also note that the examiner's concern seems to be more in the nature of a lack of antecedent under 35 U.S.C. § 112, first paragraph, or inapplicability under 35 U.S.C. § 101. We express no comment, in this opinion, as any grounds of rejection which were not brought before us.

46 USPQ2d

Ex parte Lemoine

The invention is directed to an apparatus for attaching a ski boot to a ski. In use, the apparatus is attached (1) to the ski boot through the safety bindings and (2) to the upper surface of the ski. The apparatus includes a boot supporting device or plate for attaching the boot both to the ski and to at least one safety binding. The apparatus further includes at least one support element to be positioned between the plate and the ski. In use, the support element transmits forces between the boot and upper surface of the ski. The apparatus also includes a means for mounting the support element for selective positioning relative to the plate.

The examiner presents two rejections directed to two groups of claims: (1) Claims 24 to 27, 31 to 33, 43 to 45 and 54 to 58 under 35 U.S.C. § 103 as unpatentable over the combination of the teachings of Kuchler and Smolka; and (2) Claims 28 to 30, 36 and 42 under 35 U.S.C. § 103 as unpatentable over the teachings of these same patents combined with the disclosure in Weigl.

In presenting the appeal, applicant has separately addressed each rejection, but has not separately asserted the patentability of the claims within each group. Accordingly, the claims in each group stand or fall together. 37 CFR § 1.192(c)(5). *In re Goodman*, 11 F.3d 1046, 1053, 29 USPQ2d 2010, 2013 (Fed. Cir. 1993); *In re King*, 801 F.3d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); *In re Serrano*, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983); *In re Kestrow*, 707 F.2d 1366, 1376, 217 USPQ 1089, 1096 (Fed. Cir. 1983); *In re Albrecht*, 519 F.2d 92, 93-94, 198 USPQ 208, 209 (CCPA 1978). Where an applicant does not "point out what relevance the additional limitations have to the patentability of the narrower claims," the claims will stand or fall together even if applicant asserts that the claims do not stand or fall together. *In re Herbert*, 461 F.2d 1390, 1391, 174 USPQ 259, 260 (CCPA 1972).

The 35 U.S.C. § 103 rejection based on Kuchler and Smolka

The closest prior art of record is the Kuchler patent. Kuchler relates to a ski which is said to be both shock absorbing and have improved sliding performance. Col. 1, lines 45-48. Kuchler's ski includes two separate portions which are joined together to form a torsion-resistant "box." Col. 1, lines 52 to 55. Figures 1, 2, 5 and 6 show examples of the box. The box can be an integral part of the ski structure as shown in Figure 5 or attached to the top surface of the ski as

shown in Figure 1. The box has an upper portion or surface 2. This upper portion can be used, totally or partially, as a binding plate for the ski bindings. Col. 4, lines 63-66. The box includes torsion-resistant connections made by spacers 6 and 7. *Ex. g.*, col. 3, lines 49-55. In the summary of the invention section of the patent, Kuchler describes the function of the spacers (Col. 2, lines 16-32): The torsion-resistant connection between the body portions, according to the invention, is effected by spacers which are arranged correspondingly at intervals, in front and in the back of the binding. Preferably, these spacers are displaceable, and namely in the longitudinal direction of the body portion. Thus, a simple, individual adjustment of the gliding device is possible.

The spacers can be detachably connected to the body portions. Through the modification of the distance between the displaceable spacers or of the height of the spacers, by corresponding replacing thereof, the damping characteristics can also be modified. This is of particular importance in the case of an alpine ski, since the ski can be adjusted optimally according to the weight and the skill of the skier. (Emphasis added.)

Thus, Kuchler teaches the concept of utilizing displaceable spacers to adjust the characteristics of the ski. The difference between Kuchler and the claimed subject matter is the failure of Kuchler to disclose a specific mechanism for attaching the spacers at the desired location. However, based on the level of ordinary skill in the art as represented by the references before us, we feel that one having ordinary skill in the art would have no trouble adapting readily available attachment means to this end. The person of ordinary skill in the art is presumed to know something about the art apart from what the references expressly disclose. *In re Jacoby*, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962). We conclude that it would have been obvious to include a conventional means for mounting or securing the supports or spacers on Kuchler's apparatus.

The examiner relied on the Smolka patent for the teaching of the use of safety bindings on a raised intermediate support plate. Smolka shows a ski having binding parts 1 and 2 mounted on a rigid binding plate 3. Figures 1 to 6 and Col. 1, lines 46 to 47. In light of Kuchler's teaching that the upper portion of the torsion box may take up the function of the binding plate (Col. 4, lines 63-66), it would have been obvious to attach bindings to Kuchler's upper plate. In this

regard, we note that applicant's claims do not require bindings. Rather, the claims indicate that the intended use of the intermediate plate is to support or act as a mounting for the bindings. See, for example, claims 26 and 56. In any event, to the extent the claims require or read on the inclusion of bindings, the subject matter would have been obvious over the combined teachings of Kuchler and Smolka.

In reaching this conclusion we have carefully considered applicant's arguments but have not been persuaded of error in the examiner's rejection. We fundamentally disagree with applicant's assertions as to the teachings of the Kuchler patent. Kuchler, in our view, teaches the use and positioning of spacers under a boot supporting plate or surface to affect the handling characteristics of the ski. Col. 2, lines 16-32.

The rejection of claims 24 to 27, 31 to 33, 43 to 45 and 54 to 58 is affirmed.

The rejection based on Kuchler, Smolka and Weigl

Claims 28 to 30, 36 and 42, recite an additional difference when compared with the Kuchler patent. These claims additionally require the inclusion of a means for restraining the amount of movement between the intermediate support plate and the ski. The examiner relies on the Weigl patent to show that the use of such means is old in the art. In the answer the examiner states:

Weigl is solely relied upon by the examiner to show the old and well-known use of an assembly to limit the vertical movement of a ski binding plate assembly as set forth in the office action (paper [N]o. 21). Such centrally located pivoted support parts (3) are conventional in the art and widely utilized when a control of limit of the binding plate is necessary or desired for safety reasons.

The examiner concluded that it would have been obvious to employ such restraint with respect to Kuchler's system.

Applicant argues that the incorporation of means to limit vertical movement would not have been obvious since the support elements would need to be positioned between Weigl's plate and the upper portion of the ski body which would interfere with the operation of the Weigl arrangement. It is also argued that incorporation of the Weigl arrangement would not enhance torsional resistance. Thus, it is argued one of ordinary skill in the art would not have incorporated Weigl's arrangement into Kuchler's support structure. We agree with the examiner that the subject matter of claims 28 to 30, 36 and 42

Ex parte Lemoine

46 USPQ2d

have been obvious from the combined teachings of the references. The nature of the claims and the references cited by the examiner demonstrate the high level of mechanistic ingenuity demonstrated by those working in the art. We find that the level of ordinary skill in the art includes the ability to make adaptations necessary to incorporate a ski's device into Kuchler's ski while retaining its desirable control functions. The combination of ordinary skill in the art would be to add Weigl's arrangement to obtain the benefits described in the first two columns of Weigl's patent.

Applicant in effect argues that Weigl's arrangement could not be physically incorporated into Kuchler's ski. However, the test of obviousness is not whether the disclosures of the references could be physically combined. The test is whether the invention is rendered obvious by the combined teachings of the references. *In re Eiler*, 756 F.2d 852, 225 USPQ 1, 6 (Fed. Cir. 1985). Accordingly, we affirm the rejection of claims to 30, 36 and 42.

Judge Stoner's dissent on obviousness

Judge Stoner dissents from our conclusion of obviousness. He errs in (1) giving essentially no weight to Kuchler's express teaching that the spacers are displaceable in the longitudinal direction to provide a simple manual adjustment, that the spacers can detachably be connected to the body portions, and that the spacers allow optional movement for the particular skier (Col. 2, lines 16-32) and (2) limiting the disclosure to specific embodiments and drawings. As stated by the CCPA:

It is axiomatic that a reference must be considered in its entirety, and it is well established that the disclosure of a reference is not limited to specific working examples contained therein.

Re Proctor, 681 F.2d 792, 794 n.1, 215 USPQ 569, 570 n.1 (CCPA 1982). A reference must be considered for everything it teaches by way of technology. *EWOP Corp. v. Alliance Universal Inc.*, 755 F.2d 898, 907, 5 USPQ 20, 25 (Fed. Cir.), cert. denied 4 U.S. 843 (1985). Consideration of the reference in its entirety, including both the summary of the invention and the specific examples, leads us to conclude that the claimed subject matter would have been obvious.

Conclusion

For the above-stated reasons (1) we conclude that we have jurisdiction to decide this

Ex parte Lemoine

46 USPQ2d

1427

The present application is a file wrapper continuation (FWC) application of Serial No. 07/639,095 (the '095 application). As filed, the '095 application included claims 1 through 22 directed to an apparatus for mounting a boot upon a ski.

After receiving an Office action¹ rejecting claims 1 through 22 under 35 U.S.C. § 112, second paragraph, and some of the claims under 35 U.S.C. § 103 as unpatentable over Kuchler in view of Smolka (along with an indication that some of the claims would be allowed if rewritten to avoid the § 112, second paragraph rejection), Lemoine canceled claims 1 through 22 and submitted claims 23 through 53, likewise directed to an apparatus for mounting a ski upon a boot. In the final Office action in the '095 application,² claims 23 through 53 were finally rejected under 35 U.S.C. § 112, second paragraph. Additionally, claims 23 through 27, 31, 32, 33, 43, 44, 45 and 53 were rejected under 35 U.S.C. § 103 as unpatentable over Kuchler in view of Smolka, while claims 28, 29, 30, 36 and 42 were rejected under 35 U.S.C. § 103 as unpatentable over Kuchler in view of Smolka and Weigl. Claims 23 through 53 were identified in the Notice of Appeal submitted by Lemoine in the '095 application.³

Ultimately, the appeal in the '095 application was not perfected by the filing of a brief; instead, Lemoine filed the present FWC application. By preliminary amendment⁴ in this FWC application, Lemoine added independent claim 54, from which claims 24 through 52 were made to directly or indirectly depend, as well as claims 55 through 58. At the same time, Lemoine canceled claims 23 and 53. As was true in the '095 application, the claims on this FWC application are drawn to an apparatus for mounting a ski upon a boot. It is from the rejection of these claims under 35 U.S.C. § 112, second paragraph, and 35 U.S.C. § 103 that Lemoine has appealed.

Throughout, the claims have remained drawn to substantially the same subject matter which was defined in claims 1 through 22 initially filed in the '095 application; that is, to an apparatus for mounting a boot upon a ski. At least claims 24 through 52 have survived the filing of the FWC and have been rejected in both applications on the

- ¹ Mailed April 3, 1991.
- ² Amendment filed July 3, 1991.
- ³ Mailed October 18, 1991.
- ⁴ Filed February 18, 1992.
- ⁵ Filed May 18, 1992.

same grounds and on the same evidence. As indicated above, in the '095 application, claims 23 through 27, 31, 32, 33, 43, 44, 45 and 53 were finally rejected under 35 U.S.C. § 103 as unpatentable over Kuchler in view of Smolka, the same rejection applied to claims 24 through 27, 31, 32, 33, 43, 44, 45 and 54 through 58 in the present application. Likewise, claims 28, 29, 30, 36 and 42 were finally rejected under § 103 over Kuchler in view of Smolka and Weigl in the earlier application, the same rejection applied to the like numbered claims in the present application. That no claim, including none of claims 24 through 52, has retained identical wording through two separate Office actions⁵ should not and does not, in my view, deprive Lemoine of his right to appeal from the Office action mailed July 17, 1992.⁶

Where, as here, the examiner's rejection (and underlying evidence in the form of references) remains unchanged through at least two actions on the merits, despite amendments to the claims, there is no reasonable purpose served by forcing an applicant like Lemoine to request reconsideration without further amendment prior to exercising the right to appeal conferred by 35 U.S.C. § 134.⁷ In my view, to read the statute as though it requires this futile act ill serves the applicant, for whom the right of appeal has been created by statute. Additionally, such a reading departs from a commonsense understanding of what "any of whose claims has been twice rejected" means in this context. It is on this basis that I would hold that we possess jurisdiction to decide the present appeal.

I see no need to take the view, expressed in the majority opinion, that the word "claims" in § 134 means something other than what that term is ordinarily understood to mean in the patent application examination process, that is, those claims "particularly pointing out and distinctly claiming the subject matter which the inventor regards as his invention" with which a specification is required

⁶ By virtue of a change to the language of the independent claim from which it depends, the language of a dependent claim may be likewise considered to have changed, even though the dependent claim is otherwise not amended.

⁷ While one might envision situations in which the only thing remaining from an earlier claim is its claim number, with all the language and claimed subject matter having been changed, that is not the case here.

⁸ Indeed, the fact that the examiner has seen no need to alter the basis for rejection demonstrates that virtually the same subject matter has been repeatedly claimed and rejected.

1429

Ex parte Lemoine

46 USPQ2d

The embodiment disclosed in figure 4 of Kuchler provides that the spacers may be trapezoidally shaped. Kuchler makes no mention of adjustability of the spacer location in connection with this embodiment.

The embodiment disclosed in figure 7 of Kuchler simply provides that the space between body portions 2 and 3, occupied in part by spacers 4, 5, 6 and 7, may be closed by a sponge-rubber plate 14. Kuchler makes no mention of adjustability of the spacer location in connection with this embodiment.

At first glance, Kuchler's figures 2 and 8 appear to have something to do with adjustment of spacers. The descriptions of these figures show that first impression to be erroneous. The description with regard to figure 8 reads as follows (emphasis added):

FIG. 8 shows an embodiment wherein the upper body portion 2 is given the possibility to move in longitudinal direction, with respect to the lower body portion 3. Here the spacers 6, 7 are provided with a guide peg 35 whose neck 36 passes through a longitudinal slot 19 of the upper body portion 2. This longitudinal slot 19 is formed in an elastic material 34, so that between the neck 36 and the lateral walls 33 of the longitudinal slot 19 there is practically no clearance left.

More specifically, when the two body portions 2, 3 are displaced longitudinally with respect to each other, this movement is purposely damped by the elastic material 34, respectively the conformation of the longitudinal slots 19 which results in a safe guidance of the upper body and in the preservation of the torsion-resistant box, as a whole [column 6, lines 28-44].

The description of the embodiment of figure 2 at column 5, line 61 through column 6, line 6 reveals nothing about any movement of the spacers, much less about the structure which appears to protrude from the top of each of spacers 6 and 7 in figure 2, and might be thought to resemble the peg 35 of figure 8.

It is unquestionably true that Kuchler's "SUMMARY OF THE INVENTION" makes reference to spacers which are "displaceable" in the longitudinal direction of the "body portion" and states that modification of the distance between displaceable spacers permits the damping characteristics of a ski to be adjusted to an optimal value according to the weight and skill of a skier (column 2, lines 16 through 32). In hindsight, knowing what we do of the appellant's disclosed invention, it is tempting to conclude that Kuchler's spacers are intended to be displaceable in the same manner as the appellant's claimed supporting element and that the spacers would be provided with the

undisclosed but "conventional means for mounting or securing the supports on Kuchler's apparatus" posited by the majority (ante, at 14) required to meet claims 54, 55 and 56.¹ It is also wrong.

The appellant's characterizations of Kuchler's disclosure as "ambiguous" concerning the displaceable spacers (brief, page 12) and deficient with regard to the required mounting means (brief, page 19) are well taken. When Kuchler is viewed without benefit of knowing the arrangement of elements desired by the appellant, when the entirety of Kuchler is read and appreciated for what it actually teaches the ordinarily skilled worker in the art, a conclusion contrary to that reached by the majority is required. Simply put, there is nothing whatsoever in Kuchler's specific description of the several embodiments, contained at column 5, line 44 through column 6, line 43 which remotely hints at the sort of construction claimed by the appellant.

I recognize that it is possible for a patent specification like Kuchler's to include a description of an unillustrated embodiment which would anticipate or render obvious the subject matter claimed by a later applicant. In my view, the portion of Kuchler to which the majority opinion directs attention does not do so. A reading of Kuchler's complete disclosure would have suggested to the skilled worker that the sort of change of spacing mentioned has more to do with constructing the torsion-resistant box in the first place than with any adjustability as claimed by the appellant. In this connection, I direct attention to the following statement in Kuchler:

The torsion-resistant box can be adjusted ... to the respective conditions, namely the running characteristics and skills of each user, in a simple and suitable manner, by simply replacing it. This way, it can be manufactured as a finished part and also handled as such, preferably it can be mounted on available sliding devices, particularly skis [column 2, lines 57-63].

Similarly, The absorption of such frontal shocks can also be achieved due to the fact that the spacers are rigidly connected to the lower

¹The majority has quietly abandoned most, if not all, of the position taken by the examiner in his statement of the rejection in the Office action mailed July 17, 1992, and the answer mailed October 4, 1993. The examiner appears to have bottomed his rejection on Kuchler's figure 8 embodiment, while mixing in comments pertaining to other embodiments.

²Filed June 17, 1993.

46 USPQ2d

Ex parte Lemoine

56. An apparatus for mounting a boot upon a ski, said apparatus comprising: (a) a boot-supporting device for supporting at least one ski binding for engagement of the at least one ski binding with the boot;

(b) at least one supporting element located between said boot-supporting device and an upper surface of said ski, when said apparatus is mounted upon a ski; and

(c) means for mounting said at least one support *in situ*, supporting element with respect to said boot-supporting device for selective longitudinal positioning of said at least one support *in situ*, supporting element relative to said boot-supporting device.

Of the three references upon which the examiner has relied, Kuchler is, without a doubt, the closest prior art. Each illustrated embodiment of Kuchler's skis includes, as recited in claim 56, "a boot-supporting device for supporting at least one ski binding for engagement of the at least one ski binding with the boot" defined by the "upper body portion" 2. Likewise, each illustrated embodiment of Kuchler's skis includes, as recited in claim 56, "at least one supporting element located between said boot-supporting device and an upper surface of said ski" when said apparatus is mounted upon a ski defined by spacers 6 and 7.

The several embodiments discussed and illustrated by Kuchler contain no displaceable spacers, much less any means for mounting or securing these spacers in the manner required by Kuchler's independent claims. Kuchler is primarily concerned with connecting portions of a ski to one another in a torsion-resistant manner (column 1, lines 45-58).

With regard to the embodiments of figures 1, 5 and 6, Kuchler discloses that connection of the upper body portion 2 to the lower body portion is achieved:

... via the spacers 6, 7 whereby the two body portions 2, 3 are either directly connected (through the spacers 6, 7 as in FIG. 1, or, as shown in FIG. 5, through an additionally provided transition of the upper body portion 2 into the lower body portion 3. A further possible construction of the torsion resistant box 49 is shown in FIG. 6. There, an additional body portion 48 is provided, which together with the upper portion 2 and the spacers 6, 7 form the torsion-resistant *sic*, torsion-resistant box 49 [column 5, lines 49-60].

Kuchler makes no mention of adjustability of the spacer location in connection with these embodiments.

5 U.S.C. § 412; second paragraph, to include. Construing the word "claims" in § 412 as though synonymous with "requests or claims for a patent," may lead to appeals in situations which are presently not envisioned quite removed from the kind of situation before us.

The § 103 rejections

With all due respect to my colleagues in the majority and to the examiner, I cannot agree that the combined teachings of Kuchler and Smolka render any of independent claims 54, 55 and 56 obvious. Nor do I agree with the teachings of Weigl, anything in the teachings of Weigl, applied only against certain dependent claims which makes up for the deficiency of Kuchler and Smolka.

Claim 54 defines the invention as follows, with emphasis added to denote that structure which I believe binds no response in Kuchler either of the other prior art references cited upon:

54. An apparatus for mounting a boot upon a ski, the boot adapted to be maintained between a front safety binding and a rear safety binding, said apparatus comprising:

(a) an intermediate support plate for affixation to the ski for vertically supporting the boot and for having secured thereon at least one of said front safety binding and said rear safety binding;

(b) at least one support element having a predetermined size and shape to enable said at least one support element to be positioned between said intermediate support plate and an upper surface of the ski, to enable at least vertical forces to be transmitted between said intermediate support plate and the ski;

(c) means for longitudinally displacing said at least one support element beneath said intermediate support plate and between said intermediate support plate and the ski for selectively adjusting longitudinal positions of said at least one support element; and

(d) means for immobilizing said at least one support element in predetermined longitudinal positions between said intermediate support plate and the ski. The language of claim 55 parallels that of claim 54, with the exception of clause (c), for which claim 55 substitutes a recitation of means for selectively adjusting longitudinal positions of at least one support element, a means likewise not taught by the art.

Claim 56, perhaps the broadest independent claim, defines the invention as follows, again with distinguishing emphasis added:

Ex parte Lemoine

46 USPQ2d

...portion, while with respect to the upper body portion, they are longitudinal-movable to a limited extent and lateral-guidable. The upper body portion carrying the binding can thus move with respect to the lower body portion carrying the sliding surface, so that shocks can be accepted not only in a vertical direction, but also in a horizontal direction. The longitudinal mobility is achieved, for instance, by the fact that the spacers are held in slots in the upper body portion or wave pegs guided in these slots, so that the orison-resistant construction is preserved (column 3, lines 37-51; emphasis added). I also recognize that we are to presume it on the part of the worker, rather than conversely. See *In re Sovish*, 769 F.2d 738, 6 USPQ 791 (Fed. Cir. 1985). We are not, however, authorized to speculate as to what a having ordinary skill in the art would understand a reference to mean, particularly when that speculation is guided by the appellant's own disclosure. Our court of view has repeatedly cautioned against employing hindsight by using an applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in prior art. See, e.g., *Graft Processing Corp. v. American Maize-Products Co.*, 840 F.2d 992, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988). That court has also cautioned against focusing on the obviousness of the differences between the claimed invention and the prior art rather than on the obviousness of the claimed invention as a whole as § 103 requires. See, e.g., *Hybritech Inc. v. Anticodon Antibodies, Inc.*, 802 F.2d 367, 1383, 23 USPQ 81, 93 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987). In my view, the majority has done just that in evaluating the teachings of Kuchler. Apart from whatever else they teach, neither Smolka nor Weigl has anything to do with movable spacers of the type required by the appellant's claims and, accordingly, those references do not make up for the features lacking in Kuchler.

I would reverse the § 103 rejections.

McQuade, administrative patent judge, dissenting.

This appeal is premature and should be dismissed without a decision on its merits. The pertinent facts are not in dispute. In parent application Serial No. 07/639,095, originally filed claims 1 through 22 were rejected in a first Office action dated April 3, 1991 (Paper No. 3). In response, the appellant canceled claims 1 through 22 and replaced them with new claims 21 through 53

46 USPQ2d

Ex parte Lemoine

1431

statutory right of appeal is supplemented by 37 CFR 1.191(a) which provides in pertinent part that "[e]very applicant for a patent ... any of the claims of which have been twice rejected or who has been given a final rejection (§ 1.113), may ... appeal from the decision of the examiner to the Board of Patent Appeals and Interferences." Thus, in order for this Board to have jurisdiction in an appeal, at least one of the appealed claims must be twice rejected or the claims must be under final rejection. In the present case, none of the claims on appeal has been twice rejected and the decision of the examiner appealed from was not a "final" rejection. This appeal is therefore premature and this Board does not have jurisdiction to render a decision on its merits.

The majority's determination that they have jurisdiction to decide the appeal under 35 USC 134 is predicated on their construction of the word "claims" as it appears in this statutory provision as referring to a general request or demand for a patent, rather than to claims of the type required by 35 USC 112, second paragraph. According to the majority, this interpretation is consistent with the usage of the term "claims" in 35 USC 132. In this light, it is rationalized that since the appellant's "claim" or demand/request for a patent has been denied or rejected at least twice (actually three times), 35 USC 134 affords the appellant the right to appeal to this Board.

The majority, however, has failed to advance any authority for what is, at best, a strained interpretation of the statutory language in question. The fact that this language includes the modifier "any" in conjunction with the plural term "claims" would seem to plainly and unambiguously indicate that 35 USC 134 refers to "claims" of the type required by 35 USC 112, second paragraph, not a general demand or request for a patent, and that at least one of such claims must be twice rejected for an applicant to have a statutory right to appeal the examiner's decision to this Board. This is the construction which traditionally has been accorded 35 USC 134.

For example, in *In re Szojka*, 422 F.2d 443, 164 USPQ 632 (CCPA 1970), the court stated that

[t]hose sections [112 and 134] do not require that each and every claim presented during the prosecution of an application

the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.

tion must be twice examined and twice rejected on the same ground. Section 134 appears to imply the contrary since it permits an appeal to be taken when *any* claim has been twice rejected. Nevertheless, the claims here in question have been twice rejected, contrary to appellants' allegations, since the examiner rejected them on the grounds of undue multiplicity and as being based on new matter prior to the rejection in his Answer. [164 USPQ at 635; emphasis in the original.]

In the same vein, the court in *In re Hengehold*, 440 F.2d 1395, 169 USPQ 473 (CCPA 1971) commented on the Board's observation that 35 USC 134 "states that the purpose of an appeal is to afford review of claims which have been 'twice rejected' by decision of the primary examiner," and that "[c]laims 1, 3 and 9 have not been so rejected" (169 USPQ at 477) by saying that

[o]f course, not *all* claims in the application have to have been twice rejected [169 USPQ at 477, footnote 7; emphasis in the original].

The court in *Hengehold* also stated that it is clear that, for the board to have *some* jurisdiction in a case, only *one* claim need be twice rejected [169 USPQ at 479; emphasis in the original].

As noted above, due to the substantive changes encompassed by the appellant's cancellation and replacement of independent claims during the prosecution of the parent and instant applications, none of the claims on appeal has been twice rejected.

In addition, the majority's interpretation of 35 USC 134 is inconsistent with the above-noted long-standing provision in 37 CFR 1.19(a) granting a patent applicant who has been given a final rejection the right to appeal to this Board. A final rejection may be given only on the second or any subsequent examination (see 37 CFR 1.113). It therefore follows that if a patent applicant has been given a final rejection, his or her "claim" or demand/request for a patent has been rejected at least twice. If 35 USC 134 had been intended to be construed as the majority has construed it, there never would have been any need for the foregoing provision in 37 CFR 1.19(a) since an applicant would have had a statutory right to appeal to this Board upon any second or subsequent rejection of his or her demand/request for a patent irrespective of whether such rejection was a "final" rejection.

Finally, the majority has relied on the principles that related statutory provisions should be interpreted *in pari materia* and

1432

Ex Parte Lemoine

46 USPQ2d

that statutes giving the right of appeal should be liberally construed to support their position on the jurisdictional issue. Neither of these principles, however, justifies interpreting 35 USC 134 in a manner which is completely inconsistent with the plain and unambiguous meaning of the language therein. That it might be desirable from a policy standpoint to expand the right of appeal to this Board to cover fact situations similar to that here involved is of no moment. Moreover, the implementation of such a policy is better left to the rule making authority of the Commissioner, rather than to dubious statutory constructions of the type engaged in by the majority.